

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number Q75436	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	10/667,368	September 23, 2003	
	First Named Inventor		
	Takafumi NOGUCHI		
	Art Unit	Examiner	
	2885	Jacob. Y. Choi	
<p style="text-align: center;">WASHINGTON OFFICE <b>23373</b> CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number    59,561</p> <p style="text-align: right;">/Dion R. Ferguson/ Signature</p> <p style="text-align: right;">Dion R. Ferguson Typed or printed name</p> <p style="text-align: right;">(202) 293-7060 Telephone number</p> <p style="text-align: right;">February 6, 2008 Date</p>			

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q75436

Takafumi NOGUCHI

Appln. No.: 10/667,368

Group Art Unit: 2885

Confirmation No.: 9196

Examiner: Jacob. Y. Choi

Filed: September 23, 2003

For: LIGHT-EMITTING ELEMENT

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**MAIL STOP AF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated September 6, 2007, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue. Claims 1-8 and 10-23 are the claims that have been examined in the application. Claims 1-8 and 10-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobori (US Patent 6,327,554) in view of Oda et al. (US Publication 2002/0180348).

Claim 1 is directed toward a light-emitting element which emits light itself, and recites, in part, "wherein a minimum light-emission value is equal to or less than 50% of a maximum light-emission value when white light is emitted from said light-emitting portion."

The Examiner alleges that Kobori discloses this aspect of claim 1. Specifically, the Examiner states that Kobori discloses “changes in the thickness of films forming an organic EL device, which changes in the spectra and luminance of light emitted out of the device ... [t]herefore, optimum light-emission value is desirable and the general teachings of Kobori ... provide guidance as to reconstruct/modify the thickness of films to form a highly effective EL device.”<sup>1</sup> Further, in clarifying the Examiner’s conclusion, the Examiner alleges that “various thicknesses of films forming an organic EL device was tested and results of its spectra and luminance of light emitted out of the device is taught by Kobori. Also, Figures 12-21 is evidence showing the effectiveness of spectral luminance based on the wavelengths and the thickness.”<sup>2</sup> Finally, the Examiner alleges “[f]igures 12-21 may be partial representations of the overall emissions, the overall effective ... light emissions is desirable addressing the concern that Kobori had with an organic EL device.”<sup>3</sup> The Examiner thus states that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to specify possible optimum value of the device, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.”<sup>4</sup>

Applicants respectfully submit that the Examiner has not noted a correlation between the minimum light-emission value and the spectra and luminance disclosed in FIGS. 12-21. Rather,

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<sup>1</sup> See Final Office Action dated September 6, 2007, page 3.

<sup>2</sup> *Id.* at page 11.

<sup>3</sup> *Id.* at page 12.

<sup>4</sup> *Id.* at pages 4 and 12, citing *In re Boesch*, 617, F.2d 272, 205 USPQ 215 (CCPA 1980).

the Examiner alleges that FIG. 12-21 show the effectiveness of spectral luminance based on the wavelengths and the thickness. However, while FIGS. 12-21 show emission spectrums at different ITO film thicknesses, the Examiner still provides no indication (or support) of how these emission spectrums relate an emission value comparable to a maximum emission value when white light is emitted. Therefore the Examiner has not provided a *prima facie* case of obviousness with regard to claim 1. Currently, as there is no correlation, express or inherent, the citations of FIGS. 12-21 are irrelevant to the claims.

Further, the citation given by the Examiner in support of the obviousness rejection does not support the Examiner's rejection. The Examiner's reliance on *In re Boesch* indicates that the Examiner is alleging that the minimum light-emission value recited in claim 1 is an optimum value. However, the Examiner has not provided support indicating that the recited minimum light-emission value is an optimum value of a result effective variable. Rather, the recited minimum light-emission value is nothing more than that, a minimum value. The Examiner has provided no support for the contention that the recited minimum value is an optimal value. Thus, Applicant submits that the Examiner has failed to provide a *prima facie* case of obviousness, as the motivation based on *In re Boesch* is insufficient without further support.

The maximum light-emission value as recited in claim 1 corresponds to a peak portion of the light-emission spectrum and the minimum light-emission value corresponds to a valley portion of the light-emission spectrum in proximity to the peak portion. Figs. 12-21 of Kobori fail to include the concept of the minimum light-emission value (valley) as recited in claim 1, and as a matter of course, fail to include the concept of the minimum light-emission value being

equal to or less than 50% of the maximum light-emission value when white light is emitted from the light-emitting portion. The "maximum light-emission value" and the "minimum light-emission value" are not simple maximum value and minimum value as may be construed by the Examiner, but the values at the peak portion and the valley portion near the peak portion. Figs. 12-21 of Kobori do not include the concept of peak (maximum light-emission value) and valley (minimum light emission value).

In the Advisory Action dated January 28, 2008, the Examiner argued:

Kobori states the correlation between the minimum light emission value and the spectra and luminance in column 2, lines 10-60 "... the changes in the thickness of films forming an organic EL device give rise to changes in the spectra and luminance of light emitted out of the device. In order to use this device with a display device, it is desired that characteristic variation ascribable to them to be reduced as much as possible. Never until now, however, is any argument adduced about to what degree the optical thickness is controlled ... which enables light to be effectively taken out of even a structure comprising many reflective surface"...

Note: it is noted that the features upon which applicant relies (i.e., "... the minimum light-emission value corresponds to a valley portion of the light-emission spectrum in proximity to the peak portion ... the values at the peak portion and the valley portion near the peak portion") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants respectfully submit that again, the Examiner has yet to identify an *actual* correlation between the luminance and spectra emitted out of the device in Kobori, and the minimum/maximum light-emission value when white light is emitted, as recited in claim 1. Kobori simply indicates that *variations* in the spectra and luminance emitted from the device are to be reduced as much as possible, not that the emitted spectra and luminance themselves are to

be reduced.<sup>5</sup> Thus, Kobori focuses on using the thickness of a film to obtain a particular spectra and *reducing the variations* of that particular spectra. However, contrary to the Examiner's assertion above, this reduction in variation does not correlate to the minimum *light emission* value.

With regard to the Examiner's argument that the "features upon which applicant relies ... are not recited in the rejected claims," Applicants that Applicants have not recited the graphs as part of the claims, but rather point out to the Examiner that FIGS. 12-21 of Kobori lack the requisite disclosure to render claim 1 obvious.

**Conclusion**

In view of the arguments advanced above, and those previously presented, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness. Thus, claims 1-8 and 10-23 are patentable over the applied art.

Respectfully submitted,

/Dion R. Ferguson/

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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

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Date: February 6, 2008

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<sup>5</sup> See US Patent 6,327,554 to Kobori, Col. 2, lines 10-60.